

### **Remarks**

Claims 1-12 were pending in the application and were rejected. By this paper, claims 1 and 12 have been amended, and reconsideration of the claims is respectfully requested. Furthermore, new claims 13-20 have been added.

### **Amendment to Specification**

Page 6 of the specification has been amended to recite application Serial No. 10/692,991, which corresponds to attorney docket no. LEAR 04120 PUS.

### **Claim Objections**

Claim 1 was objected to because the Examiner believes the recitation of a first opening in a wheel is unclear. Applicant respectfully disagrees with the Examiner's assertion that this recitation is unclear. The term "first opening" was merely used to distinguish that opening from the opening of the tire monitor housing. Furthermore, that a wheel may be provided with at least one hole, according to the Examiner, does not make the recitation of a "first opening" unclear.

Although claim 1 is believed to be clear as originally presented, the terms "first opening" and "second opening" have each been replaced with the term "opening." Furthermore, claim 12 has been amended in a similar manner. These amendments are not intended to narrow the scope of the claims in any way.

### **Double Patenting Rejection**

Claims 1-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/692,872. As stated by the Examiner on pp. 2-3 of the Office Action:

Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited application teaches all the basic features of the claimed invention. Except the clip as claimed in the claims herein is disclosed in the cited application as a fastener. Although the current application sets forth a clip, it would have been obvious to one having ordinary skill in the art at the time the invention was made to interpret the clip and fastener as elements that provide the same function of attaching a tire monitoring apparatus and valve stem together.

Applicant respectfully traverses this rejection. Each independent claim of the present application requires a clip that is configured to be inserted into an aperture of a tire valve stem (claim 1) or tire inflator valve assembly (claim 12), while each independent claim of the cited application requires a threaded fastener that is engageable with a threaded portion of a tire valve stem (claims 1 and 13) or tire inflator valve assembly (claim 12). None of the claims of the cited application requires a clip that is inserted into an opening. Furthermore, although the clip of the present application and the threaded fastener of the cited application may each be used to attach together a tire monitor and a valve stem, as noted by the Examiner, this does not render the claimed clip obvious over the threaded fastener, especially since the two elements function in different ways. Thus, the double patenting rejection is believed to be improper and should be withdrawn.

### **Rejection Under 35 U.S.C. § 103**

Claims 1-11 were rejected under § 103(a) as being unpatentable over Publication No. US2004/0046649A1 in the name of Sanchez et al. ("Sanchez et al."). Applicant respectfully traverses this rejection.

Claim 1 requires a valve stem having an aperture, and a clip that is configured to be inserted into the aperture and engage a housing of a tire monitor to attach together the tire monitor and the valve stem. By contrast, Sanchez et al. does not disclose any clip that is inserted into any aperture for securing a tire monitor to a valve stem. The flexible circuit 31 of Sanchez et al., which the Examiner refers to as a clip, is not inserted into an aperture of a

valve stem. Furthermore, Applicant respectfully disagrees with the Examiner's assertion that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus taught by Sanchez with apertures and openings for the purpose of attaching a tire monitoring device to a valve stem as taught by Sanchez." This is a conclusory statement that is simply not supported by the cited reference. Thus, the rejection of claim 1 and the associated dependent claims is believed to be improper and should be withdrawn.

Regarding dependent claims 2-11, Applicant respectfully disagrees with the Examiner's assertion that the features of these claims do not appear to enhance the functionality of the clip. For example, claims 2 and 3 require that the aperture of the valve stem include a second portion that is configured to allow air to pass around the clip to thereby allow air to travel through the valve stem. As another example, claim 6 requires that the housing of the tire monitor include a tab that extends into an opening in the clip when the clip is inserted into the aperture of the valve stem. As explained on page 6 of the application, this configuration helps to retain the clip in position.

Claim 12 was rejected under § 103(a) as being unpatentable over Sanchez et al. in view of U.S. Patent No. 5,928,444 to Loewe et al. ("Loewe et al."). Claim 12 requires a tire monitor having a housing with a cylindrical surface, a valve assembly having an aperture, and a clip having a main body and a cantilevered portion extending from the main body. Claim 12 further requires that the cantilevered portion be configured to be inserted into the aperture of the valve assembly, and that the main body have a cylindrical surface that is engageable with the cylindrical surface of the housing of the tire monitor. Although the Examiner acknowledged that Sanchez et al. does not disclose the above features, the Examiner argued that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the valve stem in the most appropriate and feasible configuration to detain the clip structure for the purpose of mating the tire monitoring apparatus to the valve." This argument completely ignores recited features of the claim. Furthermore, Loewe

et al. does not cure the deficiencies of Sanchez et al. Thus, the rejection of claim 12 is believed to be improper and should be withdrawn.

**New Claims**

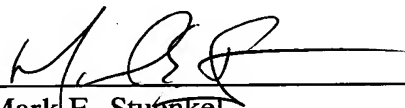
New claims 13-20 have been added for consideration by the Examiner.

**Conclusion**

Applicant has made a genuine effort to respond to each of the Examiner's objections and rejections in advancing the prosecution of this case. Applicant believes that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

Respectfully submitted,

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